



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/726,701

12/04/2003

Kazushige Hatori

00862.023346.

9227

5514

7590

02/23/2009

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

MCCOMMAS, BRENDAN N

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

02/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/726,701 | Applicant(s) HATORI ET AL. | |
| | Examiner BRENDAN MCCOMMAS | Art Unit 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/20/2008 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 11** is rejected under 35 U.S.C. 102(e) as being anticipated by Miyahara (United States Patent 6,956,665).

2. **Regarding claim 11**, Miyahara discloses a print server, method and system capable of handling different kinds of data. In addition Miyahara discloses a print service system comprising:

Art Unit: 2625

3. an acquiring unit adapted to acquire a designated type of print devices for printing a content based on a print order, as disclosed in column 8, lines 26-42;
4. a first judging unit adapted to judge whether or not the print order for the content indicates in color printing, as disclosed in column 8, lines 26-42; and
5. a print control unit adapted to control the printing of the content so as to generate a plurality of print jobs based on the print order, assign the generated plurality of print jobs to a plurality of print devices having a designated type matching with the print order, respectively, and print the content using the print order for the plurality of print devices when said first judging unit judges that the print order for the content does not indicate in color printing, but so as to generate a single print job based on the print order, assign the generated single print job to a single print device selected from among a plurality of print devices having a designated type matching with the print order, and print the content using the assigned single one print device having the designated type when said first judging unit judges that the print order for the content indicates in color printing, as disclosed in column 8, lines 44-67 and column 9, lines 52-67

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 12 and 15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara (United States Patent 6,956,665).in view of Enomoto (U.S. Patent Publication 2002/0131080).

8. **Regarding claim 12**, Miyahara discloses everything claimed as applied above (see claim 11).

9. However Miyahara fails to explicitly discloses the system further comprising a second judging unit adapted to judge whether or not the print order is a reorder, wherein, when said second judging unit judges that the print order is a reorder, said acquiring unit acquires information identifying a print device used at a previous print order and said print control unit controls the printing of the content so as to assign the generated print job to the print device identified by the acquired information and print the content using the assigned print device. However it would have been obvious to one of ordinary skill in the art to include such a modification to Miyahara, as disclosed in Enomoto.

10. In a similar field of endeavor, Enomoto discloses a print system. In addition Enomoto discloses the print system further comprising a second judging unit adapted to judge whether or not the print order is a reorder, wherein, when said second judging unit judges that the print order is a reorder, said acquiring unit acquires information identifying a print device used at a previous print order and said print control unit controls the printing of the content so as to assign the generated print job to the print device identified by the acquired information and print the content using the assigned print device, as disclosed in [0040] and [0146]-[0147].

Art Unit: 2625

11. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Miyahara, to include the modifications of Enomoto for the purpose of allowing the same print device to be used with any reorder in the print system over the network, as disclosed in [0040] and [0032] .

12. **Regarding claim 15**, Miyahara and Enomoto disclose everything claimed as applied above (see claim 11). In addition claim 15 is interpreted and rejected for the reasons set forth in the rejection of claim 11. Claim 11 describes an apparatus, and claim 15 describes the specific method used to implement the apparatus. Thus claim 15 is rejected.

13. **Regarding claim 16**, Miyahara and Enomoto discloses everything claimed as applied above (see claim 11). In addition claim 16 is interpreted and rejected for the reasons set forth in the rejection of claim 12. Claim 12 describes an apparatus, and claim 16 describes the specific method used to implement the apparatus. Thus claim 16 is rejected.

Response to Arguments

14. The Applicant's arguments received on 12/03/2008 have been fully considered but they are considered moot on the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENDAN MCCOMMAS whose telephone number is (571)270-3575. The examiner can normally be reached on IFP.

Art Unit: 2625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Brendan N. McCommas/
Examiner, Art Unit 2625

/B. M./
Examiner, Art Unit 2625

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625